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UNITED STATES PATENT AND TRADEMARK OFFICE

JAN 5 2001

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 2023
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In re

:
: DECISION ON
: PETITION FOR REGRADE
: UNDER 37 C.F.R. § 10.7(c)
:

MEMORANDUM AND ORDER

(petitioner) petitions for regrading her answers to questions 5, 8, 19, and 27 of the morning section and questions 10, and 36 of the afternoon section of the Registration Examination held on April 12, 2000. The petition is denied to the extent that the petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 68. On July 30, 2000, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, all regrade requests have been considered in the first instance by the Director of the USPTO.

OPINION

Under 37 C.F.R. § 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: "No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer which refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO," "PTO," or "Office" are used in this examination, they mean the U.S. Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers.

All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

Petitioner has been awarded one point for morning question 19. Accordingly, petitioner has been granted additional one point on the Examination. However, no credit has been awarded for morning questions 5, 8, and 27 and afternoon questions 10, and 36. Petitioner's arguments for these questions are addressed individually below.

Morning question 5 reads as follows:

5. A patent application includes the following Claim 1:

Claim 1. A method of making an electrical device comprising the steps of:

- (i) heating a base made of carbon to a first temperature in the range of 1875°C to 1925°C;
- (ii) passing a first gas over said heated base, said first gas comprising a mixture of hydrogen, SiCl_4 , phosphorus, and methane, whereby said first gas decomposes over said heated base and thereby forms a first deposited layer of silicon, phosphorus and carbon on said heated base;
- (iii) heating said base having said deposited layer to a second temperature of approximately 1620°C; and
- (iv) passing a second gas over said base heated to said second temperature, said second gas consisting of a mixture of hydrogen, SiCl_4 , AlCl_3 , and methane, whereby said second gas decomposes over said heated base to form a second deposit layer adjacent said first layer, said second layer comprising silicon, aluminum and carbon.

Assuming proper support in the specification, which of the following claims, if presented in the same application, is a proper claim?

- (A) Claim 2. The method of claim 1, wherein said first temperature is in the range of 1800°C to 2000°C.
- (B) Claim 3. The method of claim 1, wherein said first gas further comprises an inert gas.
- (C) Claim 4. The method of claim 1, wherein said second gas further comprises Argon.
- (D) Claim 5. The method of claim 1, wherein said first gas is an inert gas such as Argon.
- (E) Claim 6. The method of claim 1, wherein said second gas consists of a mixture of hydrogen, SiCl_4 and AlCl_3 only.

The model answer is choice (B).

Answers (A) and (E) are incorrect because they improperly seek to broaden the parent claim. 37 C.F.R. 1.75(c). Answer (A) broadens the range by going below the stated limit. Answer (E) broadens by trying to remove a member of the Markush group, and covering subject matter that is not covered by the parent claim. Answer (C) is incorrect because claim 1 uses the close ended claim term "consists" in connection with the second gas, which precludes the addition of further components to the second gas in claim 4. Answer (D) is incorrect because the use of the exemplary language "such as" is improper under 35 U.S.C. § 112, second paragraph, and because it is inconsistent with claim 1. See MPEP § 2173.05(d).

Petitioner argues that the correct answer is choice (A). Petitioner contends that claim 1 is a product-by-process claim and answer (A), a broadening dependent claim of a product-by-process independent claim, is permissible under MPEP 608.01(n)(II)(p. 600-67).

Petitioner's argument has been fully considered but is not persuasive. Petitioner incorrectly assumes that claim 1 is a product-by-process claim. Claim 1 is a method-of-making claim as set forth in the preamble of the claim. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 8 reads as follows:

8. Applicant received a Final Rejection with a mail date of Tuesday, February 29, 2000. The Final Rejection set a 3 month shortened statutory period for reply. Applicant files an Amendment and a Notice of Appeal on Monday, March 27, 2000. The examiner indicates in an Advisory Action that the Amendment will be entered for appeal purposes, and how the individual rejection(s) set forth in the final Office action will be used to reject any added or amended claim(s). The mail date of the examiner's Advisory Action is Wednesday, May 31, 2000. Which of the following dates is the last date for filing a Brief on Appeal without an extension of time?

- (A) Saturday, May 27, 2000.
- (B) Monday, May 29, 2000 (a Federal holiday, Memorial Day).
- (C) Tuesday, May 30, 2000.
- (D) Wednesday, May 31, 2000.
- (E) Tuesday, August 29, 2000.

The model answer is choice (D).

The answer (D) is correct. MPEP § 710.02(e), pages 700-82 and 83, under the heading "FINAL REJECTION – TIME FOR REPLY" states, "If an applicant initially replies within 2 months from the date of mailing of any final rejection setting a 3-month shortened statutory period for reply and the Office does not mail an advisory action until after the end of the 3-month shortened statutory period, the period for reply for purposes of determining the amount of any extension fee will be the date on which the Office mails the Advisory Action advising applicant of the status of the application..." Hence, since no extension fee was paid in the fact pattern, the time allowed applicant for reply to the action from which the appeal was taken is the mail date of the Advisory

Action, i.e., May 31, 2000. 37 C.F.R. § 1.192(a) recites, in pertinent part, "Appellant must, within two months from the date of the notice of appeal under § 1.191 or within the time allowed for reply to the action from which the appeal was taken, if such time is later, file a brief in triplicate." (A), (B), and (C) are wrong because they recite dates which are earlier than May 31, 2000, the last date for filing a Brief without an extension of time. (E) is wrong because it is after the last date for filing a Brief without an extension of time, and therefore an extension of time would be required.

Petitioner argues that answer (C) is more correct than the model answer. Petitioner contends that the last day for filing the appeal brief without extension of time fee is 5/30/00 because the appeal brief must be filed within 2 months of the filing of the notice of appeal and since 5/29/00 is a Federal holiday, the period for filing the brief is extended to 5/30/00. Petitioner further argues that an appeal brief mailed on 5/31/00 would necessarily require an extension, which would later be rescinded or returned upon a showing of the mailing date on the Advisory Action.

Petitioner's argument has been fully considered but is not persuasive. According to MPEP 710.02(e) (pages 700-82 and 83), the applicant could have filed the appeal brief on 5/31/00 without an extension of time. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 27 reads as follows:

27. On February 8, 1999, you filed a patent application that you prepared for Mr. Bond. The application contains only one claim. The application disclosed a composition having 20%A, 20%B, and either 60%C or 60%D. Claim 1 is as follows:

Claim 1. A composition useful for bonding semiconductor materials to metals, comprising 20%A, 20%B, and 60%C."

The examiner found a patent to Gold, dated March 8, 1998, which only disclosed and claimed a composition, having 20%A, 20%B, and 60%C, and also taught that the composition would only

be useful for insulating metals from corrosion. The examiner rejected Claim 1 under 35 U.S.C. § 102(a) as anticipated by Gold, in an Office action dated August 9, 1999. Which of the following is most likely to overcome the rejection, and comports with proper PTO rules and procedure?

- (A) Filing a reply, on March 9, 2000, with a petition for a three-month extension and the fee for a three-month extension, traversing the rejection on the ground that Gold does not disclose using the composition for bonding semiconductor materials to metals, and therefore does not disclose all the elements of Claim 1.
- (B) Filing a reply, on September 9, 1999, traversing the rejection on the ground that Gold does not disclose using the composition for bonding semi-conductor materials to metals, and therefore does not disclose all the elements of Claim 1.
- (C) Filing a reply on October 9, 1999, amending Claim 1 to state as follows: "Claim 1. A composition comprising: 20%A, 20%B, and 60%D." In the reply, pointing out why the amendment gives the claim patentable novelty.
- (D) Filing a reply on October 9, 1999, traversing the rejection on the grounds that the patent to Gold teaches away from using the invention in the manner taught in Bond's application.
- (E) Filing (i) a 37 C.F.R. § 1.132 affidavit objectively demonstrating the commercial success of the invention as claimed, and (ii) a reply containing an argument why the claimed invention is patentable, but no amendment to Claim 1.

The model answer is choice (C).

Answer (C) is correct. MPEP § 2111.02. (A), (B), and (D) are incorrect since the "use" recited in the preamble in Claim 1 does not result in a structural difference between the claimed invention and the disclosure in the Gold patent. *In re Casey*, 370 F.2d 576 (CCPA 1967). (A) is further incorrect since the reply would not be filed within the statutory period. (D) is further incorrect since the rejection is not under 35 U.S.C. § 103, and any "teaching away" in the Gold patent is not applicable to the rejection under 35 U.S.C. § 102(a). (E) is incorrect since evidence of commercial success, relevant to secondary considerations concerning rejections under 35 U.S.C. § 103, is not relevant to overcoming rejections under 35 U.S.C. § 102(a). (C) is correct since the amendment is timely filed, supported by the disclosure, and renders the rejection under 35 U.S.C. § 102(a) inapplicable.

Petitioner argues that answer (B) is more correct than answer (C). Petitioner contends that the amendment to the claim in answer (C) would introduce new matter.

Petitioner's argument has been fully considered but is not persuasive. The question states

that "[t]he application disclosed a composition having 20%A, 20%B, and **either 60%C or 60%D.**" (Emphasis added.) Hence, the specification does provide proper support for the amendment. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 10 reads as follows:

10. On December 1, 1998, Sam, attorney for the firm of Thrill and Chill, files a request for reexamination of a patent owned by his client, Hurley Corp., along with a recently discovered Russian patent which issued more than one year before the filing date of the patent. Hurley's patent contains one independent claim and nine dependent claims. The request for reexamination is granted on February 1, 1999. On June 1, 1999, an Office action issues in which the Examiner properly rejects independent claim 1 under 35 U.S.C. §§ 102 and 103 using the Russian reference and objects to the remaining claims as being dependent upon a rejected claim. Sam receives the Office action, agrees with the Examiner that claim 1 is unpatentable over the Russian patent and forwards it to his client, Hurley Corp. Hurley Corp. is undergoing financial problems and files for bankruptcy protection with the Federal District Court. They advise Sam that they have no funds available to further prosecute the reexamination proceeding. In accordance with proper PTO practice and procedure what should Sam do?

(A) Advise the Examiner on the telephone that the patentee has filed for bankruptcy protection, and that nothing should be done in the reexamination proceeding until the bankruptcy is settled.

(B) Do nothing and a reexamination certificate will issue indicating that claim 1 is canceled and that the patentability of claims 2 - 10 is confirmed.

(C) File a fallacious reply arguing the patentability of claim 1 in order to allow the reexamination proceeding to continue.

(D) File a divisional reexamination proceeding whereby claims 2 through 10 will be transferred into the divisional and allowed to issue. Claim 1, still in the original reexamination proceeding, can then be appealed to the Board of Patent Appeals and Interferences at a later point in time after the bankruptcy is resolved.

(E) Send a letter to his client Hurley Corp. advising them that unless he is paid in advance, he will take no further action in the proceeding and file no papers with the PTO.

Selection (B) is correct as per MPEP §§ 2287 and 2288. As to (E), Sam must request to withdraw and obtain permission from the PTO in accordance with 37 C.F.R. § 10.40 and MPEP § 402.06. As to (A), bankruptcy will not stay a reexamination. As to (C), false representations are prohibited by the rules. As to (D), there are no divisional reexaminations.

Petitioner argues that answer (E) is more correct than answer (B). Petitioner contends that while both answers relate to passivity in the proceedings, answer (E) is preferable because it provides notification to the client.

Petitioner's argument has been fully considered but is not persuasive. As explained in 35 U.S.C. § 305, reexamination proceedings are conducted with special dispatch. The examiner and attorney are in agreement as to the status of the claims and no amendment or response of any kind from the patent owner or attorney is required. The client knew about the rejection in the Office action and advised Sam that they have no funds, therefore notification by Sam is not needed. Furthermore, (B) is incorrect because Sam cannot ask the client to paid in advance for services that are not required. Sam must request to withdraw from representing the client and obtain permission from the PTO in accordance with 37 CFR 10.40 and MPEP 402.06. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 36 reads as follows:

36. Which of the following is **true**?

- (A) As a registered practitioner, it is not necessary to notify the Director of Enrollment and Discipline of your address changes as long as you file a change of address in each individual application for which you are responsible.
- (B) At any time the Director of Enrollment and Discipline may send out letters to registered practitioners for the purpose of ascertaining whether they wish to remain on the register and if no reply is received, without further warning, the name may be removed from the register.

- (C) A practitioner may not refuse to aid or participate in conduct that the practitioner believes to be unlawful, even though the client presents some support for an argument that the conduct is legal.
- (D) Any person who passes this examination and is registered as a patent agent or patent attorney is entitled to file and prosecute patent applications and trademark registration applications before the PTO for the same client.
- (E) It is permissible to give examiners gifts valued at between \$25 and \$250 so long as the gift is made after issuance of all patent applications that the practitioner or the practitioner's firm has before the Examiner.

The model answer is choice (B).

Answer (B) is correct, see 37 C.F.R. § 10.11(b), where "the names of individuals so removed will be published in the Official Gazette." The rule does not require notice to be published before the names of individuals are removed. As to (A), a practitioner must notify the Director as set forth in 37 C.F.R. § 10.11 (a). As to (C), see 37 C.F.R. § 10.84(b)(2). As to (D) registration only entitles one to practice before the USPTO in patent cases. 37 C.F.R. §§ 10.5 and 10.14(a). As to (E), see 37 C.F.R. § 10.23(c)(4)(iii) regarding improperly bestowing of any gift, favor or thing of value.

Petitioner argues that answer (D) is more correct than answer (B). Petitioner contends that *any* practitioner may prosecute trademark applications before the USPTO without satisfying the requirements of an examination, therefore answer (D) is a true statement.

Petitioner's argument has been fully considered but is not persuasive. A patent agent is not entitled to file and prosecute trademark registration applications before the PTO for the same client. No error in grading has been shown. Petitioner's request for credit on this question is denied.

The regrade of the petitioner's examination has been conducted fairly and without discrimination pursuant to a uniform standard using the PTO's model answers. See *Worley v. United States Patent and Trademark Office*, No. 99-1469, slip op. at 4 (D.D.C. Nov. 8, 2000)(The court held that the PTO's Model Answers are a uniform standard. "[S]ince all exams are graded in reference to [the Model Answers], use of the Model Answers fosters uniformity in

grading and preclude[s] unfair and individually discriminatory grading.” *Id.*, slip opinion at 5. The court concluded that “the decision of the Commissioner of the USPTO not to regrade Mr. Worley’s examination answers as correct when the answers did not conform with the USPTO’s Model Answers was not arbitrary and capricious.” *Id.*, slip opinion at 5-6.)

ORDER

For the reasons given above, one point has been added to petitioner's score on the Examination. Therefore, petitioner's score is adjusted to 69. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.



Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy